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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,249	10/31/2003	Masaaki Asonuma	SHO-0023	9039

23353 7590 06/02/2006

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EXAMINER
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HSU, RYAN

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/697,249	<b>Applicant(s)</b> ASONUMA, MASAOKI	
	<b>Examiner</b> Ryan Hsu	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/1/04; 4/7/05</u> | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No.**

**10/697004.** Although the conflicting claims are not identical, they are not patentably distinct from each other because both the current application and co-pending application 10/697004 are directed towards “a gaming machine comprising a game result display means for displaying a game result thereon; and beneficial state generating means for generating a beneficial state for a player when a predetermined game result is displayed on the game result display means; wherein the game result display means includes first display means and second display means arranged at a more front side than a display area of the first display means when seen from a front side of the gaming machine”. Furthermore, claim 1 of the application 10/697004 is directed towards the

“second display means having a symbol display area through which the symbols displayed on the first display means are transmittably display and window frame display areas are formed around the symbol display areas in the second display means”. With regard to claim 1 of the current application 10/697249 the second display means requires a second display means having “light transmitting symbols capable of displaying display contents of the first display means therethrough and the light transmitting symbols are variably display on the second display means”. These two requirements are directed towards the same invention where a “symbol display area” allowing light to transmittably display through the window frame display areas and the “light transmitting symbols” both describe the same ability of allowing the second display symbol to allow light symbols to be represented on the second display. Therefore it would be obvious that these two inventions are not patentably distinct but simply have used alternative synonyms and language structure to detail the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Specification*

The disclosure is objected to because of the following informalities: paragraph [0116] of the specification is directed towards co-pending applications. Paragraph [0116] first contains the error of an “Attorney Cocket No”, the Examiner believes that the attorney meant for it to be “Attorney Docket No”. Additionally, the applicant has incorporated a list of related patent applications but has referenced them using the Attorney Docket Number. Examiner stressed that if these cases are to be referenced in the case to use their correlating US patent application numbers or patent numbers. Appropriate correction is required.

### ***Drawings***

The drawings are objected to because Fig. 10 is illegible with regard to the graphical images of part (2) and (3). Examiner can not visually see what the drawings are directed towards and where the element numbers are pointed to. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Loose et al**

(US 6.

Regarding claim 1, Loose et al. disclose a gaming machine comprising a game result display means for displaying a game result thereon (*see Fig. 4 and the related description thereof*); and beneficial state generating means for generating a beneficial state for a player when a predetermined game result is displayed on the game result display means (*see col. 3: ln 41-col. 4: ln 26*). Additionally, Loose et al. disclose a game machine wherein the game result display means includes first display means and second display means arranged at a more front side than a display area of the first display means when seen from a front side of the gaming machine (*see direct image [16] of Fig. 2a and the related description thereof*). Furthermore, Loose et al. disclose a game machine wherein the second display means has light transmitting symbols capable of displaying display contents of the first display means therethrough and the light transmitting symbols are variably displayed on the second display means (*see Fig. 6 and the related description thereof*).

Regarding claim 2, Loose et al. disclose a gaming machine wherein the light transmitting symbols have specific shapes (*see Fig. 6 and the related description thereof*).

Regarding claim 4, Loose et al. disclose a gaming machine comprising light transmitting mode memory means for storing a plurality of display modes of images including the light transmitting symbols and light transmitting mode select means for selecting one or a plurality of display modes among the display modes stored in the light transmitting mode memory means (*see col. 2: ln 19-37, col. 4: ln 58-col. 5: ln 22*). Additionally, Loose et al. disclose a gaming

machine wherein the second display means display an image including the display area based on a selected result by the light transmitting mode select means (*see Fig. 6 and the related description thereof*).

Regarding claim 5, Loose et al. disclose a gaming machine wherein the first display means includes a plurality of symbol display parts capable of variably display one or a plurality of symbols and conducting stop display thereof and wherein the light transmitting symbols correspond to areas which are driven so that the player sees and recognizes a part of the symbol display parts (*see reels [12(a-c)] of Fig. 1 and the related description thereof, col. 2: ln 39-51*).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loose et al. as applied to claims above, and further in view of Mitsuo (JP 2000116843).**

Loose et al teaches a game machine that provides a variable multi-layered display screen that allows for virtual image or real image to super-imposed on a display device as taught above and is incorporated herein. Although, Loose teaches the use of lighting displays on the first display means (*ie: reel device*), it is silent with regard to a gaming machine wherein the first display means comprises rear illumination means for illuminating the first display means from a rear side thereof. Mitsuo teaches in an analogous gaming machine patent the incorporation of

illumination means from the rear side of the reels of the gaming device. Mitsuo teaches that one would be motivated to incorporate this feature in order to create a more visually stimulating and exciting experience for the user (*see Fig. 2 and the related description thereof*). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate backlit reels into the machine taught by Loose to have a variably displayed game machine that incorporates backlit illumination of the reels.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Uchiyama et al. (US 6,638,165 B2)** – Virtual Image/Real Image Superimposing and Displaying Apparatus, and Slot Machine.

**Sakamoto (US 6,315,663 B1)** – Game Machine and Method with Shifting Reels in Two Directions.

**Motegi et al. (US 6,817,946 B2)** – Virtual Image and Real Image Superimposed Display Device, Image Display Control Method, and Image Display Control Program.

Any inquiry concerning this communication or earlier communication from the examiner should be direct to Ryan Hsu whose telephone number is (571)-272-7148. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

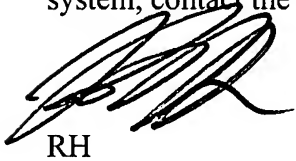
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached at (571)-272-6788.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications



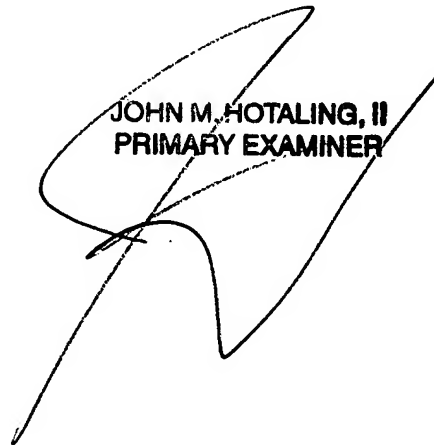
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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 1-866-217-9197 (toll-free).



RH

May 7, 2006



JOHN M. HOTALING, II  
PRIMARY EXAMINER